

REMARKS

This responds to the Office Action mailed on November 28, 2003.

Claims 2, 5, 9, 12, 15, 18, 19, 22-25, and 28 are amended, claims 1, 4, 6-8, 10 and 11 are canceled without prejudice, and no claims are added; as a result, claims 2-3, 5, 9 and 12-29 are now pending in this application.

Claims 12, 15, 18, 19, 22-25, and 28 have been amended for clarity and not in response to the art cited by the Examiner. Claim 2 has been amended to incorporate the elements of claim 1. Claim 5 has been amended to incorporate claim 4 and to depend from claim 2. Claim 9 has been amended to incorporate claim 8 and to depend from claim 2.

Claim Objections

Claims 4, 15, 19, and 25 have been objected to for informalities. Claim 4 has been canceled, thus, the objection to this claim is moot. Claims 15, 19, and 25 have been amended accordingly.

§102 Rejection of the Claims

Claims 1, 4, 6-8 and 10-11 have been rejected under 102(e) as being anticipated by Graham-Cumming, Jr., U.S. Patent No. 6,182,146. Claims 1, 4, 6-8 and 10-11 have been cancelled without prejudice. Therefore, the rejection to these claims is moot.

§103 Rejection of the Claims

Claims 2-3, 5, 9 and 12-29 have been rejected under 35 USC §103(a) as allegedly being unpatentable over Graham in view of Applicant's admitted prior art (AAPA). Applicant respectfully traverses this rejection.

Applicant does not admit that Graham is prior art, and reserves the right to challenge Graham as prior art. Nevertheless, Applicant respectfully submits that the rejection fails to make a *prima facie* case of obviousness as set forth below. Notwithstanding the failure of the rejection to meet the burden for combining Graham and the AAPA, the claims are distinguishable over the combination of Graham and AAPA set forth in the Office Action for the reasons argued below.

The Office Action has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Office Action must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

In order for the Office Action to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness because it provides not evidence of a suggestion to combine the cited references. Such a suggestion to combine must come from the prior art and not from Applicant's specification nor from impermissible hindsight.

Claim 2 recites "...when there is a host application assigned to the port number, sending a wake-up message to a host computer..."

Claim 12 recites "...when there is a host application associated with the port number, sending a wake-up message to a host computer..."

Claim 23 recites "...send a wake-up message to a host computer when there is a host application associated with the port number..."

The Office Action noted that Graham does not expressly disclose 'sending a wake-up message to a host computer.' Instead, the Action looks to AAPA and states on pages 6 and 8 of the Action:

...it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Graham to reduce power by putting the host computer to sleep then sending a wakeup message when there is a host application assigned to the port corresponding to the packet. One of ordinary skill in the art would have made the modification because this would allow power consumption to be reduced while still being able to respond only to an appropriate packet, which is desirable in Graham.

However, there is no motivation or suggestion in Graham to look to AAPA to modify Graham to form the claimed invention. For instance, Graham and AAPA address different problems: Graham addresses the problem of solving a “need to be able to handle dynamic mappings for network traffic.” (Col. 1, line 62). While AAPA, at page 2, line 22, states “Thus, there is a need for a solution that will protect a computer in a network from attack by unauthorized users and allow it to stay in the power-managed state until it receives a relevant packet.”

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

There is nothing in Graham that suggests a need to reduce power consumption nor is there anything in Graham that suggests a need to protect a computer from attack, and therefore there is no motivation or suggestion in Graham to look to AAPA to modify Graham to form the claimed invention. Accordingly, the Action relied on impermissible hindsight (i.e. Applicants' disclosure) to make the combination of references. Applicant respectfully submits that the Office Action has not provided evidence from the prior art for a suggestion or motivation to combine the references.

Accordingly, Applicants submit that claims 2, 12, and 23 are patentable.

Because claims 3, 5, 9, 13-22, and 24-29 depend from either claims 2, 12 or 23, and contain additional limitations that are patentably distinguishable over Graham and AAPA, these claims are also considered to be patentable.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney Lucinda Price at (352) 331-0202, or the below-signed attorney, to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date Jan. 23, 2004

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 26 day of January, 2004.

KACIA LEE

Name

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Signature